

REMARKS

Upon entry of the present amendment claims 17-18 and 21-26 are pending in the application. Please cancel claims 1, 7-16 and 19-20 as being drawn to a nonelected invention. Claims 2-6 have been canceled. New claim 21 adds no new matter, as support for this claim may be found at least at page 9, lines 25-28 of the Specification. Support for new claims 22-26 may be found at least in originally presented claims 2-6. Applicants respectfully request entry of the instant amendment.

1. **Rejection of claims 17 and 18 under 35 U.S.C. §103(a) as obvious over Weikard et al., U.S. 6,150,458, hereafter "Weikard" in view of Kobayashi et al., "Enzymatic Polymerization", hereafter "Kobayashi".**

Applicants greatly appreciate the detailed basis of rejection but must respectfully disagree in regards to the inventions of claims 17, 18, and 19. In particular, it is respectfully submitted that the PTO has failed to provide a *prima facie* case of obviousness with regard to the invention of claim 17 as well as dependent claims 21-26.

For an obviousness rejection to be proper, the Examiner must meet the burden of establishing that all elements of the invention are disclosed in the prior art; that the prior art relied upon, coupled with knowledge generally available in the art at the time of the invention, must contain some suggestion or incentive that would have motivated the skilled artisan to modify a reference or combined references; and that the proposed modification of the prior art will have a reasonable expectation of success, determined from the vantage point of the skilled artisan at the time the invention was made. *In re Fine*, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988); *In Re Wilson*, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970).

In this case, the instant rejection is respectfully traversed for the following reasons. The examiner has failed to establish a *prima facie* case of obviousness. To establish *prima facie* obviousness of a claimed invention, three basic criteria must be met. *See* MPEP § 2143.

First, the prior art references must teach or suggest all of the claim limitations. *See id.* For example, the combined references of Weikard and Kobayashi fail to suggest a polyester having at least one pendant or terminal group which can be activated with actinic radiation. Indeed, portions of Kobayashi appear to teach that the unsaturated groups of vinyl monomers can be polymerized by enzyme catalysts. Such teachings would lead one of skill in the art to

conclude that it would not be possible to obtain a polyester such as that claimed by Applicants using enzyme catalysts since such Kobayashi teaches that unsaturated groups are polymerizable via enzyme catalysts.

In addition, both references are silent as to the required limitations of dependent claims 21-26. Kobayashi is silent as to the particular enzymes employed by Applicant's inventions of claims 22-26 as well as the amounts required in Applicants' claim 21.

Second, there must be some suggestion or motivation in the references themselves to modify the reference or to combine reference teachings. *See id.* None of the references contain any suggestion or motivation to one of ordinary skill in the art to modify or combine the references. In particular, the PTO has failed to show how Kobayashi can suggest a polymer curable with actinic radiation. Indeed, nothing in Kobayashi indicates that any of their resultant 'polymers' of Kobayashi appear to be curable, let alone curable with actinic radiation. Indeed, most of the Kobayashi 'polymers' appear to be simple sugars. Moreover, as noted above, Kobayashi teaches that vinyl monomers are polymerizable with enzyme catalysts. As a result, one of skill in the art would not expect to obtain an actinically curable polyester. A reference that teaches away from the claimed invention is a significant factor to be considered in determining obviousness. MPEP 2145.D.1; see *In re Gurley*, 31 USPQ2d 1130 (Fed. Cir. 1994).

It is submitted that the PTO is really suggesting that it would be obvious to try the enzymes of Kobayashi to make the polyesters of Weikard. However, a finding of 'obvious to try' does not provide the proper showing for an obviousness determination. The requirement for a determination of obviousness is that "both the suggestion and the expectation of success must be founded in the prior art, not in applicant's disclosure" (emphasis added). *In re Dow Chem.*, 837 F.2d 469, 473, 5 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1988). An Examiner, then, cannot base a determination of obviousness on what the skilled person in the art might try or find obvious to try. Rather, the proper test requires determining what the prior art would have led the skilled person to do. In this case, nothing indicates in Kobayashi that it would be possible to retain a pendant or terminal group that is actinically activatable.

Third, there must be a reasonable expectation of success. *See id.* At the time of the patentee's invention, a person of ordinary skill in the art must have had a reasonable expectation of success in combining the cited references to produce Applicants' required process for

producing particular actinically curable polyesters. At the relevant time, a person of ordinary skill in the art would not have had a reasonable expectation of success in combining the prior art references to create Applicants' claimed process of making actinically curable polyesters. In this case, those of skill in the art appreciate the unpredictability of polymerization, especially polymerization of functional polymers having terminal or pendant groups that might be vulnerable to polymerization by the identified catalyst group.

Taken as a whole, it is respectfully submitted that the cited combination fails to provide the requisite motivation for a prima facie case of obviousness.

Reconsideration and removal of the obviousness rejection of claims 17-26 is respectfully requested in view of the foregoing remarks.

CONCLUSION

Applicant(s) respectfully submit that the Application and pending claims are patentable in view of the foregoing amendments and/or remarks. A Notice of Allowance is respectfully requested. As always, the Examiner is encouraged to contact the Undersigned by telephone if direct conversation would be helpful.

Respectfully Submitted,

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